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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,122	02/02/2006	Michael Klingenberg	P2107-287	1804
2352 7590 11/24/2010 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
MCINTOSH III, TRAVIS C				
ART UNIT		PAPER NUMBER		
1623				
MAIL DATE		DELIVERY MODE		
11/24/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/561,122

**Applicant(s)**

KLINGEBERG ET AL.

**Examiner**

TRAVISS C. MCINTOSH III

**Art Unit**

1623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47, 50-73 and 75-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47, 50-73 and 75-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date 9/10/10
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

The Amendment filed September 10, 2010 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claim 47 has been amended.

Claims 1-46, 48-49, and 74 have been canceled.

Claim 78 has been added.

Remarks drawn to rejections of Office Action mailed 6/11/10 include:

112 2<sup>nd</sup> paragraph rejections: have been overcome by applicants' amendments and have been withdrawn.

112 1<sup>st</sup> paragraph rejections: have been overcome by applicants' amendments and have been withdrawn.

102(b) rejections: which have been maintained for reasons of record.

103(a) rejection: which has been maintained for reasons of record.

An action on the merits of claims 47, 50-73, 75-77, and 78 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 47, 50-53, 60-72, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Tangsen et al. (The Natural New-Type Sweetening Agent”, from 6/7/2007 IDS), is maintained for reasons of record. Newly added claim 78 is rejected herein additionally.

Tangsen et al. disclose palatinitol ingestion which shows that the absorption rate is low, most metabolites are utilized and fermented by microorganisms in the intestines to produce small molecular organic acids, CH<sub>4</sub>, CO<sub>2</sub>, H<sub>2</sub>, and so on, which are discharged outside the body. Thus, Tangsen discloses administering palatinitol which acts as prebiotic. Prebiotics are known to be selectively fermented ingredients that allow specific changes, both in composition and/or activity in the gastrointestinal microflora that confers benefits upon the hosts well-being and health. Tangsen notes that palatinitol can be used to treat diseases such as hepatic coma and so on (see top of page 4). Tangsen states that there are palatinitol-containing foods on the market, such as candies, chocolates, kernel soft candies, chewing gums, ice creams, jellies, jams, etc. It is noted that the mixture applicants are seen to be using, as evidenced by claim 53, is isomalt. Isomalt is the same product as palatinitol (see section 1.2 on page 2 which provides palatinitol is a mixture of 1,6-GPS and 1,1-GPM). As such, the methods of administering the same products to the same population would have necessarily produced the same results. Thus, the step of administering the compositions would have performed functions such as: restoring intestinal flora; maintaining a healthy intestinal epithelium; supporting intestinal health; reducing toxic and harmful intestinal contents; reducing oxidative stress; and strengthening the immune system. The examiner would like to note that Tangsen et al.'s methodological step of administering their isomalt composition

DNA would have inherently performed the method as instantly claimed. It is noted that if Tangsen et al., having taken the manipulative steps described therein, had attempted to measure for the results as described in the instant application, Tangsen would have uncovered those results, as they are directly correlative to the method as practiced therein. Applicant's discovery of differing effects of a prior art method does not give the discoverer a right to exclude others from practicing the prior arts method of using isomalt containing products as claimed, as the prior arts method would have inherently performed the method as instantly claimed. See Ex Parte Novitski, 26 USPQ 2d (BNA) 1389. A hypothetical example clarifies this principle. Humans lit fires for thousands of years before realizing that oxygen is necessary to create and maintain a flame. The first person to discover the necessity of oxygen certainly could not have obtained a valid patent claim for "a method of making a fire by lighting a flame in the presence of oxygen." Even if prior art on lighting fires did not disclose the importance of oxygen and one of ordinary skill in the art did not know about the importance of oxygen, understanding this law of nature would not give the discoverer a right to exclude others from practicing the prior art of making fires. EMI v. Cypress Semiconductor, 2001 US Fed. Cir. Ct. of App. As such, Tangsen teaches the instantly claimed mixture has prebiotic effects and the steps of administration would necessarily produce the results instantly claimed.

Applicants arguments filed 9/10/10 have been considered but are not persuasive. Applicants argue that the reference does not disclose that isomalt has a bifidogenic function and upon consumption leads to an increase in the proportion of bifidobacteria in the intestinal tract. Likewise, applicants argue that the claimed mixture serves as a substrate for the formation of butyric acid in the gastrointestinal tract, which both serve to promote health in the intestinal tract.

The examiner would like to note that the reference discloses administration of the same mixture, isomalt, which would necessarily produce the same results applicants have claimed by practicing the same claimed step which is taught in the art, administration. A compound and its properties are inseparable. See *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). As noted, the reference discloses the administration of the same product, whose properties would be tied directly to the product and the overlapping method, administration. The steps of "forming a consumable sufficient to serve as a bifidogenic prebiotic and as a butyrate-supplying substrate", "producing a human food", "producing an animal feed", "producing a medicament", "treating a bowel disorder", "stabilizing or restoring intestinal flora", "maintaining a relatively healthy intestinal epithelium", "supporting intestinal health", etc., by administering the same composition to the same population would necessarily produce the same effects and results. The art discloses the same active steps, administration, and thus anticipates the methods instantly claimed. Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

The rejection of claims 47, 50-56, 60-65, 67-73, and 75-77 under 35 U.S.C. 102(b) as being anticipated by US 6,139,864 is maintained for reasons of record. Newly added claim 78 is rejected additionally.

The '964 patent discloses isomalt compositions which have antibacterial effects. The compositions are taught to be combined with additional saccharides (see column 2, lines 25-37); included in medicaments and foods (see column 2, lines 38-65); and combined with various active agents (see column 4, lines 53-65). As such, the same compositions (isomalt containing compositions) are taught to be used with the same populations, thus would necessarily produce the same results.

Applicants arguing that the reference fails to disclose that the isomalt-containing mixtures in the art does not have bifidogenic or butyrogenic functions is not convincing. As set forth supra, the examiner would like to note that the reference discloses administration of the same mixture, isomalt, would necessarily produce the same results applicants have claimed by practicing the same claimed step which is taught in the art, administration. A compound and it's properties are inseparable. See *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of claims 47, 50-73 and 75-77 under 35 U.S.C. 103(a) as being unpatentable over Tangsen et al. (The Natural New-Type Sweetening Agent”, from 6/7/2007 IDS) as applied to claims 47, 50-53, 60-72, 77, and 78 above, and further in view of EP0904784, is maintained for reasons of record.

The claims of the instant application are drawn to methods of forming consumable products with a mixture of 1,6-GPS and 1,1-GPM to serve at least one of a prebiotic function and a fermentable substrate and/or to serve as a bifidogenic prebiotic and as a butyrate-supplying substrate. Dependent claims provide the mixture is isomalt; additional dietary agents are added thereto; the mixture is in the form of food/feed; and used as a medicament. Also claimed are methods of treating bowel disorders; restoring intestinal flora; maintaining a healthy intestinal epithelium; supporting intestinal health; reducing toxic and harmful intestinal contents; reducing oxidative stress; treating chronic inflammatory bowel disorder; treating infectious diseases; and strengthening the immune system.

Tangsen et al. disclose palatinitol ingestion which shows that the absorption rate is low, most metabolites are utilized and fermented by microorganisms in the intestines to produce small molecular organic acids, CH<sub>4</sub>, CO<sub>2</sub>, H<sub>2</sub>, and so on, which are discharged outside the body. Thus, Tangsen discloses administering palatinitol which acts as prebiotic. Prebiotics are known to be selectively fermented ingredients that allow specific changes, both in composition and/or activity in the gastrointestinal microflora that confers benefits upon the hosts well-being and health. Tangsen notes that palatinitol can be used to treat diseases such as hepatic coma and so on (see top of page 4). Tangsen states that there are palatinitol-containing foods on the market, such as candies, chocolates, kernel soft candies, chewing gums, ice creams, jellies, jams, etc. It is noted that the mixture applicants are seen to be using, as evidenced by claim 53, is isomalt. Isomalt is the same product as palatinitol (see section 1.2 on page 2 which provides palatinitol is a mixture of 1,6-GPS and 1,1-GPM). What is not taught is to add the additional agents such as Lactobacillus and Bifidobacterium.

The '784 patent bridge the gap in teaching to add various micro-organisms to prebiotic/probiotic compositions, such as Lactobacillus and Bifidobacterium. See abstract.

It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be prima facie obvious.). See also *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote the formation of a nodular structure in cast iron.); and *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held prima facie obvious). In the instant case, Tangsen discloses administering palatinitol which acts as prebiotic. '784 teaches to add various micro-organisms to prebiotic/probiotic compositions, such as Lactobacillus and Bifidobacterium. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the art recognized agents, to form a new composition which will be used for the very same purpose with these references before them. One would have been motivated to combine these agents to form a new composition which would be used for the very same purpose.

Applicants argue that Tangsen fails to anticipate the instant claims, and thus cannot render obvious the instant claims. However, the examiner would like to note that the reference is

seen to still anticipate the instant claims, and thus also serves as a basis to render obvious the instant claims.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAVISS C. MCINTOSH III whose telephone number is (571)272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traviss C McIntosh III/  
Primary Examiner, Art Unit 1623  
November 22, 2010